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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,657	10/09/2003	Jack Polonka	J6860(C)	8243

201 7590 05/04/2006

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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/682,657

Applicant(s)

POLONKA, JACK

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Acknowledgment is made of the response filed 2/9/06. Claims pending are 1-20.

#### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 2/9/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on US Application SN 10/841,867 has been reviewed and is accepted. The terminal disclaimer has been recorded.
2. The terminal disclaimer filed on 2/9/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on US Application SN 10/841,042 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Double Patenting***

3. Applicant is advised that should claim 6 be found allowable, claim 20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

#### ***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. The rejection of Claims 1-9, 11-13 and 15-20 under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2004/0120908) is maintained for the reasons of the record.
6. The rejection of Claim 10 under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2004/0120908) in view of either Dreher (US 2003/0157041) or Miyazaki et al. (US 6,482,419) is maintained for the reasons of the record.
7. The rejection of Claims 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Cohen et al. (US 2004/0120908) in view of Tan et al. (US 6,511,672) is maintained for the reasons of the record.

### ***Response to Arguments***

8. Applicant's arguments filed 2/9/06 have been fully considered but they are not persuasive.

The Applicant argues:

"The '908 reference teaches away from the presently claimed invention since the presently claimed invention is directed to a composition having an opacity of less than about 20%, and therefore, a light transmission value of 80% or more (achieved by using single-crystals with smooth crystal reflective facets as defined in the specification at page 6). Note that the transmission values of the composition described in the '908 reference are no greater than 70%. Moreover, in paragraph 0016 of the '908 reference, it is taught that the ingredients used in the formula should in combination exhibit a light transmission value from 20-70%. Furthermore, the particles employed in the presently claimed invention have an index of refraction of about 1.8 to about 2.2. These particles are single-crystal, flat, platy particles. No such requirements are even remotely suggested or required in the compositions described in the '908 reference." See p. 6 of the reply.

In response, it has been held that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See *In re Susi*, 169 USPQ 423 (CCPA 1971). A known or obvious composition is not patentable simply because it has been described as somewhat inferior to some other product for the same use. See *In re Gurley*, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). See MPEP 2123. In this case, the Cohen et al. reference teaches that the platelet compounds "should also exhibit some transparency, i.e. at least about 20% transmission of light, but generally no greater than about 70%." See [0010]. The passage is talking about a compound, not the entire composition, as suggested by the Applicant. Moreover, the compound referred to by the reference is the same as used in the instant invention, i.e. pearlescent interference platelet of bismuth oxychloride sold under the commercial name Biron B-50. With respect to the reference's teaching in paragraph [0016] ("*As a rule, the remainder of the ingredients used in the formula should, in combination, exhibit a light transmission level in the range of from about 20 to about 70%*"), this is merely a preferred embodiment, which does not constitute "teaching away". Furthermore, in the same paragraph, Cohen et al. teach that "it is preferred that the additional components be transparent or nearly so, so as to avoid opacifying the composition to such an extent that the sheer, natural effect is lost". This teaching simply cannot be ignored by the Applicant. Further, it is noted that the Applicant's claims recite an opacity of "less than about 20%". The term "about" indicates that there is no criticality associated with that number and the opacity can "a

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little more" or "a little less" than 20%. As discussed above, Cohen et al. teach that the light transmission of the compositions should be, as a rule (i.e. preferably), "from about 20 to about 70%". The teaching of "to about 70%" in the reference also encompasses the light transmission slightly over 70%, which meets the limitations of "opacity of less than about 20%" and "opacity of less than about 10%" in the instant claims.

Further, the Applicant argues:

"As set forth in paragraph 008 of the '908 reference, the compositions described are base compositions for any type of cosmetic product that can have color or treatment agents. The presently claimed composition is an end use composition to be used to enhance skin radiance, yielding to the consumer a natural skin finish. It is not a base/filler composition." See p. 6 of the reply.

In response, Cohen et al. clearly teach compositions having "sheer, natural effect" and suggest "to avoid an overall opacity". See [0016]. "The compositions, when applied to the skin, have the effect of diminishing or eliminating the appearance of skin blemishes, while permitting surrounding clear skin to retain its normal, healthy appearance". See [0005].

With respect to the rejection of Claim 10 as being unpatentable over Cohen et al. in view of either Dreher or Miyazaki et al. and the rejection of Claims 13 and 14 as being unpatentable over Cohen et al. in view of Tan et al., the Applicant argues that neither one of the supplemental references "cure" any of the "vast deficiencies" of Cohen et al. See pp. 7-10 of the reply. In response to the Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference and not is it that the claimed invention must be expressly suggested in any one or all of the references; but rather the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Once a prima facie case of obviousness has been made the burden of going further is shifted to applicant. *In re Keller*, 642 F.2d 4B, 208 USPQ 871, 882 (CCPA 1981). This applicant has not done so, but rather argues the references individually and not their combination.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

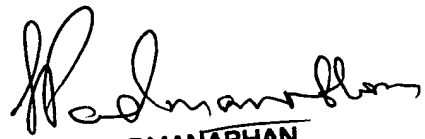
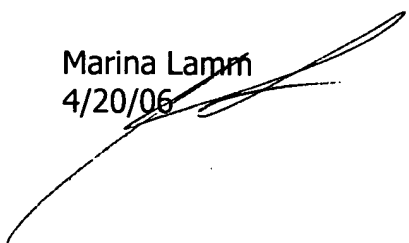
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Sreenivasan Padmanabhan, can be reached at (571) 272-0629.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Lamm  
4/20/06



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER